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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,679	02/03/2004	Judith Reichenbach	3896-040076 (P-5974)	4034
32182 7590 08/09/2007 DAVID W. HIGHET, VP AND CHIEF IP COUNSEL BECTON DICKINSON AND COMPANY [THE WEBB LAW FIRM] FRANKLIN LAKES, NJ 07414-1880			EXAMINER OMGBA, ESSAMA	
			ART UNIT 3726	PAPER NUMBER
			MAIL DATE 08/09/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/771,679

Applicant(s)

REICHENBACH ET AL.

Examiner

Essama Omgba

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 1-25 and 37-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-32 is/are rejected.
- 7) ☒ Claim(s) 33-36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5/6/2004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species:

Species A: figures 2-6

Species B: figures 7-9B

Species C: figure 10

2. The species are independent or distinct because species A uses a spacing element adjacent the open end of the outer tube to vent air from an annular gap, Species B uses a recess on the inner surface of the outer tube, the recess being adjacent the open end of the outer tube and Species C has a protrusion on the inner surface of the outer tube adjacent the open end.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations

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of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

3. During a telephone conversation with Mr. Kirk Miles on July 30, 2007 a provisional election was made with traverse to prosecute the invention of Species B, claims 26-36. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-25 and 37-48 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Applicant's election with traverse of the invention of Group I, claims 1-16 and 26-36, in the reply filed on May 18, 2007 in response to the restriction requirement mailed March 26, 2007 is acknowledged. The traversal is on the ground(s) that there is no undue burden on the examiner in examining the claims in Groups I and II. This is not found persuasive because Applicant has not provided any showing or evidence to support such conclusion. Clearly, consideration of additional claims drawn to one or more distinct groups of inventions in diverse categories of subject matter (as illustrated by the disclosed unrelated species listed above) mandates different fields of search with the associated concomitant hundreds to thousands of patents and time consuming

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evaluation of those patents which gives rise to a sizeable burden on the examiner.

Applicant has not established that the inventions of Group I and Group II are not distinct, and subsequently that Species A, B and C are not distinct.

The restriction requirement mailed March 26, 2007 is still deemed proper and is therefore made FINAL.

Drawings

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "longitudinal groove extending between the recess on the inner surface of the outer tube to the open end of the outer tube" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

7. The abstract of the disclosure is objected to because the phrase "The present invention is directed to" in line 1 should be deleted. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 26-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Morony et al. (US Patent 4,771,911).

With regards to claim 26, Morony et al. discloses a method of assembling a container comprising an inner tube 13 contained within an outer tube 12, wherein the outer tube includes a closed bottom, an open top and a side wall extending therebetween, the side wall defining an inner surface and an outer surface, the inner surface having a recess adjacent the open top thereof, the inner tube including a closed

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bottom, an open top and a side wall having an inner surface and an outer surface extending therebetween, the side wall of the inner tube being shorter than the side wall of the outer tube and including an outwardly flared portion 17 adjacent the open top of the inner tube, wherein the inner tube is inserted within the open top of the outer tube to a position in which the outwardly flared portion of the inner tube extends below a top edge of the recess of the inner surface of the outer tube, and wherein contact of the outwardly flared portion within the recess sealingly supports the inner tube within the outer tube, see column 2, lines 31-52 and figure 1.

For claim 27, Applicant should note that it is inherent that any air trapped between the inner and outer tube of Morony et al. Will pass through the recess and vent in the atmospheric pressure.

For claim 28, the flared portion of inner tube 13 will contact the top edge of the recess when inserting the inner tube in the outer tube.

For claims 29 and 30, the recess of the outer tube extends circumferentially around the inner surface of the outer tube and extends longitudinally to the open end of the outer tube.

For claim 31, see figure 1.

For claim 32, see column 2, lines 46-52. Since there is an interference fit where flange 17 abuts against conical shoulder 18, it is inherent that flange 17 is deformed when inner tube 13 is inserted in outer tube 12.

Allowable Subject Matter

10. Claims 33-36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion


11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Essama Omgba whose telephone number is (571) 272-4532. The examiner can normally be reached on M-F 9-6:30, 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Essama Omgba
Primary Examiner
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eo
August 4, 2007